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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/819,168	03/27/2001	Shinichiro Okamoto	A-391	3886
802	7590	12/03/2004		
DELLETT AND WALTERS P. O. BOX 2786 PORTLAND, OR 97208-2786			EXAMINER NGUYEN, BINH AN DUC	
			ART UNIT 3713	PAPER NUMBER

DATE MAILED: 12/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/819,168

Applicant(s)

OKAMOTO ET AL.

Examiner

Binh-An D. Nguyen

Art Unit

3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 14-18 and 45-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 14-18 and 45-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The Amendment filed September 2, 2004 has been received. According to the Amendment, claims 1, 14, 45, and 49 have been amended, and claims 9-13, 19-44, and 50 have been canceled. Currently, claims 1-8, 14-18, and 45-49 are pending in the application. Acknowledgment has been made.

2. Claim 49 is unclear since each claim does not include a term such as "comprising" to define where the preamble ends and the body of the claim starts.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-8, 14-18, and 49 are rejected under 35 U.S.C. 102(e) as being anticipated by Miyamoto et al. (6,139,433).

Miyamoto et al. teaches a game machine having an information storage medium (54) for storing a video game program (Fig.1; 1:47-2:29) comprising: movement instructing unit (or means) for instructing the movement of a player character (Mario) in a three-dimensional virtual space (Fig.23D-26A; 2:30-40; 12:50-67); space setting unit

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(or means) for setting the shapes of said player character and an object existing around the player character, and their arrangement in said virtual space (2:41-67; 13:1-16); image generating unit (or means) for generating an image in said virtual space as looked from a virtual visual point position (views from different camera angles)(3:1-4:8); timing decision unit (or means) for deciding the timing at which said player character and said object satisfy relatively a predetermined relation for at least one of the shapes and the arrangement in said virtual space (e.g. player character changing shape or pose at different moving speeds or actions; player character interacts with surrounding objects)(3:18-48; 25:66-26:67); a timer for measuring a fixed time after said timing decision unit (or means) decides that said player character and said object satisfy the predetermined relation (hardware and software interrupts)(10:57-11:19); and visual point position setting unit (or means) for shifting said visual point position along with the movement of said player character so that said player character may be contained in a visual field range, and changing said visual point position in a predetermined range almost centered at said player character, when the elapse of said fixed time is detected by said timer or when a change instruction is made by said change instructing unit (or means)(e.g., zooming or scaling desired views)(25:47-26:19; 45:10-31), wherein the elapsed time (or predetermined duration) is greater than zero (45:10-31; Fig. 32); timing decision unit (or means) decides the timing at which said player character is intercepted in the visual field by said object, as looked from said visual point position in a direction toward said player character, on the basis of the shapes of said player character and said object and their arrangement in said virtual space; timing decision unit (or means)

decides the timing at which said object is contained in a predetermined range around said player character; said visual point position is set above the height of said player character, and said timing decision unit (or means) decides the timing for said object above the height of said player character (corresponding to player's controlled views); visual point position setting unit (or means) changes said visual point position by rotating said visual point position by a predetermined angle around a rotational center of said player character position; said image generating unit (or means) generates said image continuously while said visual point position is being rotated by said visual point position setting unit (or means); said visual point position setting unit (or means) continues an operation of rotating said visual point position, until said player character is kept from being intercepted by said object as looked from said visual point position; return instructing unit (or means) for making a return instruction of returning the changed visual point position to an original state, when said visual point position is changed, wherein said visual point position setting unit (or means) returns said changed visual point position to the original state, when the return instruction is made by said return instructing unit (or means) (33:15-40; 34:15-58; 39:20-36; 46:6-28).

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 45-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyamoto et al. (6,139,433) as applied to claims 1-8, 14-18, and 49 above, and further in view of Rieder (6,017,272).

Miyamoto et al. (6,139,433) teaches all limitations of claims 1-8, 14-18, and 49. Miyamoto et al. does not explicitly teach the limitations of return instructing unit for making a return instruction of returning the changed degree of transparency for the object to an original state, when the degree of transparency for said object is changed; and transmission processing unit for performing a transmission process of changing the degree of transparency for the object placed between said player character and said visual point position, when said timing decision unit decides that said player character and said object satisfy the predetermined relation, as well as returning the changed degree of transparency to the original state, when a return instruction is issued by said return instructing unit (claim 45).

Rieder, however, teaches a video game system and method having video game program stored in computer readable medium comprising a return instructing unit (or means) for making a return instruction of returning the changed degree of transparency for the object to an original state, when the degree of transparency for said object is changed (Fig. 3; 8:22-46); and transmission processing unit (or means) for performing a transmission process of changing the degree of transparency for the object placed between said player character and said visual point position, when said timing decision unit (or means) decides that said player character and said object satisfy the predetermined relation, as well as returning the changed degree of transparency to the

original state, when a return instruction is issued by said return instructing unit (or means) (Figs.4-8; 2:17-67; 8:47-67).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to provide transparency objects of Rieder to the video game having multiple view setting angles of Miyamoto et al. to provide user total controllable views in the video game thus attract more game players and increase sales of the game software.

7. Applicant's arguments filed September 2, 2004 have been fully considered but they are not persuasive.

Applicant's arguments regarding Miyamoto et al.(6,139,433) not teaching the limitations of visual point position setting unit for shifting said visual point position... when the elapsed time of said fixed time is detected by said timer" (applicant's remarks, page 19, last paragraph to page 21) is not persuasive. Miyamoto et al. teaches player character interacts with surrounding objects (3:18-48; 25:66-26:67); a timer for measuring a fixed time after said timing decision unit (or means) decides that said player character and said object satisfy the predetermined relation (hardware and software interrupts)(10:57-11:19); and visual point position setting unit (or means) for shifting said visual point position along with the movement of said player character so that said player character may be contained in a visual field range, and changing said visual point position in a predetermined range almost centered at said player character, when the elapse of said fixed time is detected by said timer or when a change

instruction is made by said change instructing unit (or means)(e.g., zooming or scaling desired views)(25:47-26:19; 45:10-31), wherein the elapsed time (or predetermined duration) is greater than zero (45:10-31; Fig. 32).

Further, in response to applicant's argument that the combination of Miyamoto et al. and Rieder (6,139,433) would not enable one skilled in the art to make applicant's claims 45-48 (applicant's remarks, page 22), the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Furthermore, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "providing a delayed visual point repositioning" (applicant's remarks, pages 17-18)) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). As being presented in the claims, the visual point position setting unit shifts the visual point position along with the movement of the character in different viewing positions, and the detection of elapsed time by the timer would time the switching of the visual point position from one view to another; this feature does not cover or support the limitation of "providing a delayed visual point repositioning."

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binh-An D. Nguyen whose telephone number is 571-272-4440. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on 571-272-7147. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

BN



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PRIMARY EXAMINER
AU3713